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AVERP2720US PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appellants	:	Group Art Unit:	1771
Edward I. Sun et al.	:	Examiner:	D. Zirker
Serial No. 09/531,978	:	Confirmation No.:	6960
Filed: March 20, 2000	:		

For: CONFORMABLE AND DIE-CUTTABLE BIAXIALLY ORIENTED FILMS AND LABELSTOCKS

Mail Stop Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION - 37 CFR 192)

1. Transmitted herewith is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on January 12, 2005 which bears a USPTO date stamp of January 18, 2005.

2. **STATUS OF APPLICANT**

This application is on behalf of

[X] other than a small entity

[ ] small entity

3. **FEE FOR FILING APPEAL BRIEF**

Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is:

[ ]	small entity	$250.00
[X]	other than a small entity	$500.00

Appeal Brief fee due $500.00

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(Signature of person faxing paper)

4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply.

(a) [ ] Applicant petitions for an extension of time under 37 CFR 1.17(a)-(d) for the total number of months checked below:

	Extension (months)	Fee for other than small entity	Fee for small entity
[ ]	one month	$ 120.00	$ 60.00
[ ]	two months	$ 450.00	$225.00
[ ]	three months	$1,020.00	$510.00
[ ]	four months	$1,590.00	$795.00

Fee $_____

If an additional extension of time is required please consider this a petition therefor.

[ ] An extension for _____ months has already been secured and the fee paid therefor of $_____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request $_____
or

(b) [X] Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that Applicant has inadvertently overlooked the need for a petition and fee for extension of time.

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TOTAL FEE DUE $500.00

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[X] Charge Account No. 18-0988 the sum of $500.00

7. FEE DEFICIENCY

[X] If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 18-0988.

AND/OR

[X] If any additional fee for claims is required, charge Account No. 18-0988.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket No: AVERP2720US

In re Appellants	Group Art Unit:	1771
Edward I. Sun et al.	Examiner:	D. Zirker
Serial No. 09/531,978	Confirmation No.:	6960
Filed: March 20, 2000		

For: CONFORMABLE AND DIE-CUTTABLE BIAXIALLY ORIENTED FILMS AND LABELSTOCKS

APPEAL BRIEF

VIA FACSIMILE
M/S Appeal Briefs - Patents
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

This Appeal Brief is submitted in the above-identified application in response to the final Office Action mailed October 15, 2004 and the Advisory Action mailed December 22, 2004. Appellants' Notice of Appeal was filed on January 12, 2005. Accordingly, Appellants' Appeal Brief is timely filed, with no extension of time.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket No: AVERP2720US

In re Appellants:	:	Group Art Unit: 1771
Edward I. Sun et al.	:	Examiner: D. Zirker
Serial No. 09/531,978	:	Confirmation No.: 6960
Filed: March 20, 2000	:	

For: CONFORMABLE AND DIE-CUTTABLE BIAXIALLY ORIENTED FILMS AND LABELSTOCKS

APPEAL BRIEF

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

This Appeal Brief is submitted in the above-identified application in response to the final Office Action mailed October 15, 2004 and the Advisory Action mailed December 22, 2004. Appellants' Notice of Appeal was filed on January 12, 2005.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Avery Dennison Corporation, 150 North Orange Grove Boulevard, Pasadena, California, 91103. 37 C.F.R. §41.37(c)(1)(i).

II. RELATED APPEALS AND INTERFERENCES

Appellants are aware of no related appeals or interferences. 37 C.F.R. §41.37(c)(1)(ii).

III. STATUS OF CLAIMS

Claims 56-69, 76-87 are presently pending in the Application. Claims 1-55 and 70-75 have been canceled as drawn to non-elected inventions. Claims 56-69 and 76-87 stand

finally rejected and are the subject of the present Appeal. The Appendix contains a copy of the claims on appeal. 37 C.F.R. §41.37(c)(1)(iii).

Appellants note for the record that the Examiner included claims 70-75 in the rejections contained in the first Office Action of this RCE on July 16, 2004 and the second Office Action of October 12, 2004, and Appellants' responses of July 29, 2004 and August 17, 2004 included reference to claims 70-75. However, claims 70-75 were not, and are not pending in this application since claims 70-75, along with claims 1-55, were cancelled in the amendment filed on June 14, 2002 as directed to non-elected inventions. Accordingly, claims 70-75 are not subject to the present appeal even though listed in the final rejection by the Examiner and included in the Notice of Appeal filed on January 12, 2005.

IV. STATUS OF AMENDMENT

No amendment under 37 C.F.R. 1.116(a) was filed in this application. Thus, at the present time, there is no amendment pending. 37 C.F.R. §41.37(c)(1)(iv).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants' summary of the claimed subject matter is set forth in the following, in compliance with 37 C.F.R. §41.37(c)(1)(v).

The present invention, in one embodiment, relates to the discovery that labelstocks comprising a biaxially stretch-oriented multilayer film and an adhesive layer can be prepared which are characterized as having improved conformability (page 21, lines 8-9), die-cuttability (page 15, lines 27-30), and/or dispensability (page 32, lines 4-14). In some embodiments, films having improved clarity can be prepared. Although conformable films often have poor die-cutting properties, the present invention provides conformable films that have acceptable die-cutting properties (page 15, lines 27-30), and, therefore, these films may be used for labeling bottles and tubes or in other label applications that require clarity and conformability (page 32, lines 9-14). Multilayered film constructions can be prepared in accordance with the present invention having skin layers designed to provide

printability (page 31, lines 5-15), or to provide other desirable characteristics such as stiffness (page 20, lines 18-30) or both.

Appellants' invention in one embodiment as described in claim 56 relates to an adhesive containing labelstock (page 28, line 24) for use in adhesive labels (page 28, lines 24-25), and the labelstock comprises

(A) a die-cuttable, biaxially oriented multilayer film (page 28, line 26) comprising

(A-1) a base layer having an upper surface and a lower surface (page 16, lines 9-10 and page 28, lines 28-29), and comprising polyethylene having a density of about 0.940 g/cm^3 or less, a propylene polymer or copolymer, or mixtures thereof wherein the base layer is free of copolymers of ethylene with an ethylenically unsaturated carboxylic acid or ester (page 16, lines 9-13 and page 28, lines 28-32), and

(A-2) a first skin layer of a thermoplastic polymer bonded to the upper surface of the base layer (page 16, lines 14-15 and page 20, lines 1-2), wherein the tensile modulus of the multilayer film in the machine direction is greater than the tensile modulus in the cross direction (page 16, lines 15-16 and page 29, lines 2-4), and the tensile modulus of the multilayer film in the cross direction is 150,000 psi or less (page 21, lines 1-15), and

(B) an adhesive layer having an upper surface and a lower surface wherein the upper surface of the adhesive layer is adhesively joined to the lower surface of the base layer (page 29, lines 6-8).

In another embodiment as described in claim 60, the base layer is free of inert particulate filler (page 16, lines 27-28).

In yet another embodiment as described in claim 83, the invention relates to adhesive containing labelstocks for use in adhesive labels (page 28, lines 24-25), and the labelstock comprises

(A) a die-cuttable, biaxially oriented multilayer film (page 28, line 26) having an overall thickness of from about 1 mil to about 3.5 mils (page 19, lines 22-24) and comprising

(A-1) a base layer having an upper surface and a lower surface, and comprising polyethylene having a density of about 0.940 g/cm^3 or less, a propylene polymer or copolymer, or mixtures thereof wherein the base layer is free of copolymers of ethylene with an ethylenically unsaturated carboxylic acid or ester, (page 16, lines 9-13 and page 28, lines 28-32) and

(A-2) a first skin layer of a thermoplastic polymer bonded to the upper surface of the base layer (page 16, lines 14-15 and page 29, lines 1-2), wherein the tensile modulus of the multilayer film in the machine direction is greater than the tensile modulus in the cross direction (page 16, lines 15-16 and page 29, lines 2-4), and the tensile modulus of the multilayer film in the cross direction is 150,000 psi or less (page 21, lines 1-15), and the biaxially oriented multilayer film has been oriented in the machine direction at a stretch ratio of from about 5:1 to about 10:1 (page 19, lines 14-15) and in the cross direction at a stretch ratio of from greater than 1:1 up to about 5:1 (page 19, line 18); provided the stretch ratio in the cross direction is less than the ratio in the machine direction (page 19, lines 16-18); and

(B) an adhesive layer having an upper surface and a lower surface wherein the upper surface of the adhesive layer is adhesively joined to the lower surface of the base layer (page 29, lines 6-8).

In yet another embodiment as described in claim 85, the adhesive labelstocks of the invention comprise

(A) a die-cuttable, biaxially oriented multilayer film (page 28, lines 26) comprising

(A-1) a base layer having an upper surface and a lower surface, and comprising polyethylene having a density of about 0.940 g/cm^3 or less, a propylene polymer or copolymer, or mixtures thereof wherein the base layer is free of copolymers of

ethylene with an ethylenically unsaturated carboxylic acid or ester (page 16, lines 9-13 and page 28, lines 28-32), and

(A-2) a first skin layer of a thermoplastic polymer bonded to the upper surface of the base layer (page 16, lines 14-15), wherein the stretch-orientation of the multilayer film in the machine direction is greater than the stretch-orientation in the cross direction by at least 10% (page 19, lines 11-12) and the tensile modulus of the multilayer film in the cross direction is 150,000 psi or less (page 16, lines 17-18 and page 29, lines 4-5), and

(B) an adhesive layer having an upper surface and a lower surface wherein the upper surface of the adhesive layer is adhesively joined to the lower surface of the base layer (page 29, lines 6-8).

An exemplary process for preparing the adhesive containing labelstocks of the invention is set forth on page 30, line 1 to page 31, line 4.

In yet another embodiment of the invention as described in claim 69, the invention relates to pressure sensitive adhesive labels which are die cut from the labelstocks described above (page 31, lines 16-19).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants' concise statement of each ground of rejection presented for review is set forth in the following, in compliance with 37 CFR §41.37(c)(1)(vi).

> Claims 56-59, 61-69, 76-81 and 83-87 stand rejected under 35 USC §102(b) as anticipated by, or, in the alternative, under 35 USC §103(a) over Japanese Patent Kokai 59/49971 Translation.
>
> Appellants' claims 60 and 82 stand rejected under 35 USC §103(a) as unpatentable over Japanese Patent Kokai 59/49971 Translation.

VII. ARGUMENT

In compliance with 37 CFR §41.37(c)(1) (vii), Appellants' arguments with respect to each ground of rejection presented for review are as follows.

(A) Appellants' claims 56-59, 61-69, 76-81 and 83-87 are not anticipated by and would not have been obvious over Japanese Patent Kokai 59/49971 translation.

Claims 56-59, 61-69, 83-87 have been rejected by the Examiner as anticipated by, or in the alternative, obvious over Japanese Patent Kokai 59/49971 translation (hereinafter referred to as JP '971). Appellants respectfully traverse this rejection for the reasons which follow, and Appellants request the Board to reverse the Examiner's rejection of the claims as anticipated by or in the alternative, obvious over this reference.

In support of the rejection of claims 56-59, 61-69, 76-81, and 83-87, the Examiner has noted in particular, the claim on page 1, the discussion on page 3, line 1 through page 5, line 20, particularly page 5, lines 5-8, the paragraph bridging pages 6-7, and the example of JP '971 (Paper No. 070104, page 3). It is the Examiner's position that

> The reference discloses what appears to be, at least in certain embodiments, Applicants' claimed multilayer adhesive coated film wherein an imitation paper polyolefin film which comprises a biaxially oriented polyolefin film containing fillers is disclosed as being laminated to an oriented polyolefin film....With respect to the composition of each of the base and first skin layer, both polypropylene, ethylene-propylene and polyethylene resins may be utilized as well as a wide variety of inorganic particles, nucleating agents and the like. (Paper No. 070104, page 3).

In addition, the Examiner suggests at page 3 that the polyolefin film 1 in certain embodiments (not identified) "inherently possess" the required Young's modulus parameter and the films 1 and 2 are disclosed (e.g., the Example on page 14) as being biaxially oriented lengthwise and widthwise before being thermoset. The Examiner also suggests (page 4) that "which direction constitutes lengthwise or widthwise is either inherent or at most an obvious design parameter". The composite in JP '971 is provided with an adhesive layer (paragraph bridging pages 6-7). Accordingly, the Examiner concludes that the invention of the rejected claims is anticipated (inherent) in JP '971 or the claims are obvious over the disclosure of JP '971.

Appellants respectfully submit that the Examiner has not demonstrated or provided sufficient support for the suggestion that the multilayer film of JP '971 inherently possesses the properties of the films of the presently claimed invention. In addition, the Examiner has failed to identify all of the required elements of a prima facia case of obviousness. Specifically, the Examiner has failed to provide any teaching in JP '971 which would motivate one skilled in the art to prepare a multilayer film having the properties set forth in the claims. In particular, there is no teaching or suggestion in JP '971 of or any incentive to prepare a multilayer film comprising a die-cuttable, biaxially oriented multilayer film wherein the tensile modulus of the multilayer film in the machine direction is greater than the tensile modulus in the cross direction, and the tensile modulus of the multilayer film in the cross direction is 150,000 psi or less. Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 58 USPQ 2d 1286 (Fed. Cir. 2001). Moreover, JP '971 does not teach or

suggest all the limitations of the claims. In re Wilson, 422 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

(1) The claims are not anticipated.

The Examiner's rejection of the claims as anticipated based upon inherency should be reversed. There is no basis for the Examiner to conclude that the multilayer films of JP '971 inherently possess the properties of the films of the presently claimed invention. In fact, a reading of JP '971 indicates the Young's modulus parameters are totally different from the modulus parameters specified in the present claims.

JP '971 neither teaches nor suggests labelstocks comprising biaxially oriented multilayer films wherein the tensile modulus of the multilayer film in the machine direction is greater than the tensile modulus in the cross direction. Additionally, JP '971 neither teaches nor suggests multilayer films wherein the tensile modulus in the cross direction is 150,000 psi or less.

In claim 1 on page 1 of the translation cited by the Examiner, there is described a polyolefin film comprising an oriented polyolefin film 1 containing 10 to 40% of a filler and an oriented polyolefin film 2 having a surface glossiness of 30 or less which is laminated on at least one side of film 1. There is nothing contained in this teaching that would suggest that the film 1 or the multilayer film obtained by combining films 1 and 2 would inherently have the characteristics specified in the appealed claims.

With regard to pages 3-5 of JP '971 cited by the Examiner, there is no teaching or suggestion contained on these pages that would even suggest that the properties of the film specified in the appealed claims are inherently contained in the films described on pages 3-5. In fact, the Example noted by the Examiner which appears on pages 14 and 15, and the Comparative Examples found on pages 16-18 of the English translation clearly indicate that the films which are the subject matter of JP '971 do not inherently possess the properties ascribed to the presently claimed films. For example, with regard to the multilayer films described in pending claims 56-59, 61-69, 76-81, 83 and 84, the films described in the Example found on pages 14-15 and the Comparative Examples found on pages 16-17 of JP '971 are characterized by a tensile modulus relationship which is opposite to that specified in the appealed claims. The rejected claims specify that the tensile modulus of the film in the machine direction (i.e., lengthwise) is greater than the tensile modulus in the cross direction (i.e., widthwise). In the Example on pages 14 and 15 of JP '971 the biaxially oriented film produced in the Example is reported to have a Young's modulus of elasticity of 103 kg/mm^2 lengthwise (i.e., machine direction) and 180 kg/mm^2 widthwise (cross direction). Thus, the modulus in the machine direction is less than the modulus in the cross direction, not greater than as specified in the appealed claims.

Similarly, the film prepared in Comparative Example 1 of JP '971 is characterized as having a Young's modulus of elasticity of 200 kg/mm^2 lengthwise which is less than the modulus of elasticity widthwise which is reported to be 360 kg/mm^2. Also, the film prepared

in Comparative Example 2 has a Young's modulus of 93 kg/mm^2 lengthwise which is less than the Young's modulus of 150 kg/mm^2 widthwise.

Claims 85-87 specify that the stretch orientation in the machine direction (lengthwise) exceeds the stretch orientation in the cross direction (widthwise) by at least 10%, and claim 86 specifies at least 20%. In contrast, in the Example of JP '971 the film stretch orientation is 3.5 times in the machine direction and 9 times in the cross direction. Thus, the stretch orientation in the machine direction is less than the stretch orientation in the cross direction.

Moreover, all of the claims under consideration specify that the tensile modulus in the cross direction is 150,000 psi or less. This parameter is not inherent in JP '971, and JP '971 teaches away from such low modulus. In the Example on pages 14-15 of JP '971, the modulus in the cross direction (widthwise) is reported as 180 kg/mm^2 which is equivalent to about 256,000 psi. The modulus in the cross direction of the film of Comparative Example 1 of JP '971 is even higher, namely, 360 kg/mm^2. In Comparative Example 2, the modulus in the cross direction is 150 kg/mm^2 or 213,000 psi.

In view of these differences between the teachings of JP '971 and the subject matter of the claims under appeal, Appellants respectfully submit that the rejection of the claims as anticipated by JP '971 should be reversed.

It is well known that when a prior art reference does not expressly set forth a particular element of the claim, the reference may still anticipate if that element is "inherent" in its disclosure. However, to support an anticipation rejection based on

inherency, the Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. See Ex Parte Levy, 17 USPQ 2d 1461, 1464 (Bd. Pat. App & Int., 1990). Also, as noted by the Federal Circuit in In re Robertson, 49 USPQ 2d 1949, 1950, (1999)

> To establish inherency, the extrinsic evidence "must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill" Continental Can Co. v Monsanto Co., 948 F2d 1264, 1268, 20 USPQ 2d 1747, 1749 (Fed Cir. 1991).
>
> Inherency however may not be established by a probability or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Id. 1269, 20 USPQ 2d at 1749 (quoting In re Oelrich, 666 F2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

Although Appellants may have disclosed some of the same materials for the layers as disclosed in JP '971, the tensile modulus values specified in Applicants' claims for the multilayer film are not inherent for the polymers selected for the base layer and the skin layer. The tensile values specified in Applicants' claims are for the multilayer film, and these values primarily are a result of the type of orientation conducted on the multilayer film. Appellants' multilayer films are biaxially oriented to provide that the tensile modulus of the multilayer film in the machine direction is greater than the tensile modulus in the cross direction, and the tensile modulus in the cross direction is 150,000 psi or less (claims 56-69 and 76-83). In claims 85-87, a biaxially stretched oriented multilayer film is claimed wherein the stretch orientation of the multilayer film in the machine direction is greater than

the stretch-orientation in the cross direction by at least 10%, and the tensile modulus of the multilayer film in the cross direction is 150,000 psi or less. The Examiner has not provided any factual or technical grounds establishing that these features are inherent in JP '971 because they "necessarily flow" from the teachings of the prior art. (Ex parte Levy, supra.)

(2) Claims 56-59, 61-69, 76-81 and 83-87 are not obvious over JP '971.

The rejection of claims 56-59, 61-69, 76-81 and 83-87 as being obvious over JP '971 also should be reversed. Although JP '971 describes multilayer films comprising some of the same polymers included in Applicants' claimed film, and teaches that the films may be oriented either uniaxially or biaxially, Applicants respectfully submit that there is no teaching or suggestion in JP '971 which would make it obvious to prepare a biaxially oriented multilayer film wherein

(1) The tensile modulus in the machine direction is greater than the tensile modulus in the cross direction, and

(2) The tensile modulus in the cross direction is 150,000 psi or less, or

(3) The film stretch orientation in the machine direction is greater than the stretch orientation in the cross direction.

On page 3, JP '971 teaches that "ordinarily, the films 1 are biaxially oriented", and on page 4, JP '971 teaches that "the films 2 are at least uniaxially, preferably biaxially oriented". On page 9, JP '971 teaches that a multilayer film of 2 or 3 layers is "biaxially oriented lengthwise and widthwise sequentially, followed by relaxation, heat treatment and surface

treatment". Alternatively, JP '971 teaches that a composite polyolefin film can be prepared by extruding a polyolefin resin containing a filler, molding, orienting lengthwise, and thereafter laminating a second polyolefin film resin using a different extruder on the first layer, thereafter orienting the laminated composite film widthwise. (Note that in this embodiment one layer of the composite film is biaxially oriented, and the second layer is uniaxially oriented only). No details of the orientation are given in any of the above teachings of JP '971, and there is no teaching or discussion of the desirability of controlling the tensile modulus of the films lengthwise and widthwise.

As mentioned previously, the only mention of the details of biaxial orientation in JP '971 is found in the Example on pages 14 and 15, and in the Comparative Examples beginning on page 16. In all three examples,

(1) The tensile modulus (Young's modulus) of the multilayer film lengthwise is less than the tensile modulus widthwise, and

(2) The tensile modulus of the multilayer films in the cross direction is significantly greater than 150,000 psi, and

(3) The film stretch orientation in the machine direction is less than the stretch orientation in the cross direction.

For example, in the Example on pages 14 and 15, the multilayer film has a Young's modulus of elasticity of 103 kg/mm^2 lengthwise (i.e., machine direction) and 180 kg/mm^2 widthwise (cross direction). Thus, the modulus in the machine direction is less than the modulus in the cross direction, not greater than as specified in the appealed claims. Also, in the example on pages 14-15 of JP '971, the stretch orientation is 3.5 times lengthwise

and 9 times widthwise, and the modulus widthwise (cross-direction) is reported as 180 kg/mm^2 which is equivalent to about 256,000 psi.

Accordingly, it is respectfully submitted that there is no teaching or suggestion in JP '971 which would motivate one skilled in the art to prepare a multilayer film having the characteristics specified in the appealed claims.

Moreover, the Examiner's suggestion that any differences between the present claims and JP '971 are obvious because they amount to mere optimization of properties for one of ordinary skill in the art is respectfully traversed. A tensile modulus in the machine direction greater than the tensile modulus in the cross direction; a stretch orientation in the machine direction greater than the stretch orientation in the cross direction; and a multilayer film having a tensile modulus of 150,000 psi or less in the cross direction do not amount to an optimization of the parameters disclosed in JP '971. The parameters taught in JP '971 would lead one skilled in the art away from such parameters and properties.

Accordingly, Appellants respectfully request the Board to reverse the Examiner's rejection of claims 56-59, 61-69, 76-81 and 83-87 as obvious over JP '971.

In the final Office Action mailed from the Patent Office on October 15, 2004, the Examiner contended that Appellants' conclusion that the "Young's modulus parameters are totally different from the modulus parameters specified in the main claims" has simply not been proven,.... (Page 2). Appellants respectfully submit that such proof may be derived from Appellants' written description and the disclosure of JP '971. It is clear, as described

in detail above, that the only teachings of tensile modulus, and the relationship between the tensile modulus in the machine direction and the tensile modulus in the cross direction found in JP '971 is found in the examples, and the values specified therein are totally different from the parameters specified in the appealed claims. Appellants are not aware of any case law that requires Appellants to reproduce examples of the prior art to prove that the parameters specified in the prior art are indeed obtained. Examples 12-14 of the present application, which illustrates the preparation of biaxially stretched-oriented multilayer films, demonstrate: (1) multilayer films having the properties presently claimed such as a stretch orientation in the machine direction which exceeds the stretch orientation in the cross direction by at least about 10%; (2) multilayer films having a tensile modulus in the machine direction which is greater than the tensile modulus in the cross direction; and (3) multilayer films having a tensile modulus in the cross direction of less than 150,000 psi.[1]

[1]In the final rejection, the Examiner has suggested that the different properties have not been proven in a declaration "which examines more than one specific embodiment such as was set forth in the previously cited reference, Appendix 5" "films TS&B Lab Report" of September 16, 1997 in which one specific embodiment, the Example in JP '971 was tested. The Examiner's mention of this "cited reference" is not understood since Applicants have not relied upon any declaration in the responses which have been filed in the present application. Moreover, Appellants submit that the identification of the "cited reference" is incomplete since it is not possible to determine which cited reference contains Appendix 5.

(B) Claims 60 and 82 would not have been obvious over Japanese Patent Kokai 59/49971.

Claims 60 and 82 have been rejected as being obvious over JP '971. Appellants respectfully traverse these rejections and request the Board to reverse the Examiner's rejection of claims 60 and 82. Since both claims are dependent from claim 56, the rejection of claims 60 and 82 as obvious over JP '971 should be reversed for the same reasons given above with respect to claim 56.

In addition, claim 60 further specifies that the base layer is free of inert particulate filler. In support of the rejection, of claim 60, the Examiner suggests that the reference teaches at page 4, top paragraph, that if white and opaque films are not desired, the filler content can be less than 10 wt. %", and presumably states that the statement that the filler content can be less than 10 wt. % presumes that the filler content can be 0 wt. percent". (Paper No. 070104, page 5).

The rejection of claim 60 should be reversed because the Examiner's interpretation of JP '971 with respect to filler content is in error. JP '971 does not teach that "the filler content can be less than 10%". JP '971 teaches a multilayer film wherein an oriented polyolefin film 1 contains 10-40 wt. % of a filler (see claim on page 1 of translation). On page 4 of the translation, JP '971 states

> if the content of the fillers is less than 10 wt. %, white and opaque films cannot be obtained. On the other hand if said content is more than 40 wt. %, resultant films are fragile since they are incapable of retaining the mechanical strength required. These possibilities are both undesirable.

The Appellants respectfully submit that JP '971 does not teach that the "filler content can be less than 10 wt. %", but in fact teaches that the filler content cannot be less than 10 wt. %. JP '971 teaches that if the wt. % of the filler is less than 10%, the desired oriented film "cannot be obtained". JP '971 clearly teaches away from the preparation of a multilayer film wherein the base layer contains no filler. In re Haruna, 239 F2d 1327, 58 USPQ 2d 1517 (Fed. Cir. 2001). The modification suggested by the Examiner would render JP '971 inoperative for the intended purpose so there is no motivation to prepare a film free of filler. In re Fritch 972 F2d 1260, 1265 n. 12, 23 USPQ 2d 1780, 1783 n. 12 (Fed. Cir. 1992). The rejection of claim 62 should be reversed.

With respect to claim 82 which teaches that the biaxially oriented multilayer film is prepared by simultaneous biaxial orientation, the Examiner has maintained that although this process is not specifically taught by the reference, it is believed to be well within the ordinary skill in the art in the absence of unexpected results. For the reasons given above with respect to the rejection of claim 56 from which claim 82 depends, and in the absence of any suggestion in the reference to prepare the product by "simultaneous" biaxial orientation, it is submitted that claim 82 is not obvious over JP '971, and the rejection should be reversed.

VIII. CONCLUSION

For all of the above reasons, the rejection of Appellants' claims 56-59, 61-69, 76-81 and 83-87 as being anticipated by or obvious over JP '971, and the rejection of claims 60 and 82 as being obvious over JP '971 should be reversed.

If any additional fees are required for the filing of this paper, the Commissioner is authorized to charge those fees to Deposit Account #18-0988, our Order No. AVERP2720US.

Respectfully submitted,

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APPENDICES:

CLAIMS SUBJECT TO APPEAL

In accordance with 37 C.F.R. §41.37(c)(1)(viii), the following claims are the subject of the present appeal:

56. An adhesive containing labelstock for use in adhesive labels which comprises

(A) a die-cuttable, biaxially oriented multilayer film comprising

(A-1) a base layer having an upper surface and a lower surface, and comprising polyethylene having a density of about 0.940 g/cm^3 or less, a propylene polymer or copolymer, or mixtures thereof wherein the base layer is free of copolymers of ethylene with an ethylenically unsaturated carboxylic acid or ester, and

(A-2) a first skin layer of a thermoplastic polymer bonded to the upper surface of the base layer, wherein the tensile modulus of the multilayer film in the machine direction is greater than the tensile modulus in the cross direction, and the tensile modulus of the multilayer film in the cross direction is 150,000 psi or less, and

(B) an adhesive layer having an upper surface and a lower surface wherein the upper surface of the adhesive layer is adhesively joined to the lower surface of the base layer.

57. The labelstock of claim 56 wherein the base layer comprises a propylene copolymer.

58. The labelstock of claim 56 wherein the base layer comprises a propylene copolymer which is a copolymer of propylene and up to about 40% by weight of at least one α-olefin selected from ethylene and α-olefins containing from 4 to about 8 carbon atoms.

59. The labelstock of claim 58 wherein the α-olefin is ethylene or 1-butene.

60. The labelstock of claim 56 wherein the base layer is free of inert particulate filler.

61. The labelstock of claim 56 wherein the base layer comprises polyethylene having a density of from about 0.890 to about 0.925 g/cm^2.

62. The labelstock of claim 56 wherein the multilayer film (A) has been biaxially stretch-oriented and heat set.

63. The labelstock of claim 56 wherein the multilayer film (A) has a Gurley stiffness in the machine direction of from about 10 to about 50.

64. The labelstock of claim 56 wherein the stretch orientation of the multilayer film (A) in the machine direction is greater than the stretch orientation in the cross direction by at least about 20%.

65. The labelstock of claim 56 wherein the multilayer film (A) has been stretched in the machine direction at a ratio in the range of from about 5:1 to about 10:1.

66. The labelstock of claim 56 wherein the adhesive layer is a pressure-sensitive adhesive layer.

67. The labelstock of claim 56 wherein the multilayer film (A) has been oriented in the machine direction at a stretch ratio of about 9:1 to about 10:1, and stretch oriented in the cross direction at a ratio of greater than 1:1 up to about 3:1.

68. The labelstock of claim 67 wherein the stretch ratio in the cross direction is less than 2:1.

69. A pressure-sensitive adhesive label die-cut from the labelstock of claim 56.

76. The labelstock of claim 56 wherein the stretch orientation of the multilayer film (A) in the machine direction is greater than the stretch orientation in the cross direction by at least about 10%.

77. The labelstock of claim 56 wherein the multilayer film (A) has a frictional energy of less than 120 g-cm.

78. The labelstock of claim 56 wherein the multilayer film (A) has a frictional energy of less than 80 g-cm.

79. The labelstock of claim 56 wherein the multilayer film has been stretched in the cross direction at a ratio of from greater than 1:1 to about 5:1.

80. The labelstock of claim 56 wherein the overall thickness of the multilayer film is from about 1 to about 3.5 mils.

81. The labelstock of claim 56 wherein the multilayer film has a haze of less than about 6%.

82. The labelstock of claim 56 wherein the biaxially oriented multilayer film is prepared by simultaneous biaxial orientation.

83. An adhesive containing labelstock for use in adhesive labels which comprises

(A) a die-cuttable, biaxially oriented multilayer film having an overall thickness of from about 1 mil to about 3.5 mils, and comprising

(A-1) a base layer having an upper surface and a lower surface, and comprising polyethylene having a density of about 0.940 g/cm^3 or less, a propylene polymer or copolymer, or mixtures thereof wherein the base layer is free of copolymers of ethylene with an ethylenically unsaturated carboxylic acid or ester, and

(A-2) a first skin layer of a thermoplastic polymer bonded to the upper surface of the base layer, wherein the tensile modulus of the multilayer film in the machine direction is greater than the tensile modulus in the cross direction, and the tensile modulus of the multilayer film in the cross direction is 150,000 psi or less, and the biaxially oriented multilayer film has been oriented in the machine direction at a stretch ratio of from about 5:1 to about 10:1 and in the cross direction at a stretch ratio of from greater than 1:1 up to about 5:1; provided the stretch ratio in the cross direction is less than the ratio in the machine direction; and

(B) an adhesive layer having an upper surface and a lower surface wherein the upper surface of the adhesive layer is adhesively joined to the lower surface of the base layer.

84. The labelstock of claim 83 wherein the stretch orientation of the multilayer film (A) in the machine direction is greater than the stretch orientation in the cross direction by at least about 20%.

85. An adhesive containing labelstock for use in adhesive labels which comprises:

(A) A die-cuttable, biaxially stretch-oriented multilayer film comprising

(A-1) a base layer having an upper surface and a lower surface, and comprising polyethylene having a density of from about 0.940 g/cm^3 or less, a propylene

polymer or copolymer, or mixtures thereof wherein the base layer is free of copolymers of ethylene with an ethylenically unsaturated carboxylic acid or ester, and

(A-2) a first skin layer of a thermoplastic polymer bonded to the upper surface of the base layer, wherein the stretch-orientation of the multilayer film in the machine direction is greater than the stretch-orientation in the cross direction by at least 10%, and the tensile modulus of the multilayer film in the cross direction is 150,000 psi or less, and

(B) an adhesive layer having an upper surface and a lower surface wherein the upper surface of the adhesive layer is adhesively joined to the lower surface of the base layer.

86. The labelstock of claim 85 wherein the stretch-orientation in the machine direction is greater than the stretch-orientation in the cross direction by at least about 20%.

87. The labelstock of claim 85 wherein the film has been stretched in the machine direction at a ratio of from about 5:1 to about 10:1.

EVIDENCE

In accordance with 37 C.F.R. §41.37(c)(1)(ix), Appellants note that in the present application there is no evidence submitted pursuant to 37 C.F.R. § 1.130, 1.131, or 1.132 or any other evidence entered by the examiner and relied upon by Appellants in the appeal.

RELATED PROCEEDINGS

In accordance with 37 C.F.R. §41.37(c)(1)(x), Appellants note that in the present application there are no related appeals or interferences therefore there is no documentation relating to such proceedings.